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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,260	03/09/2004	Thomas Killion	3057-0013	2379
7590	07/03/2006			EXAMINER EWALD, MARIA VERONICA
E. VICTOR INDIANO INDIANO VAUGHAN ROBERTS & FILOMENA, LLP SUITE 850 ONE NORTH PENNSYLVANIA STREET INDIANAPOLIS, IN 46204			ART UNIT 1722	PAPER NUMBER
DATE MAILED: 07/03/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	10/796,260	KILLION, THOMAS
	Examiner Maria Veronica D. Ewald	Art Unit 1722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) 21-23 is/are withdrawn from consideration.
- 5) Claim(s) 20 is/are allowed.
- 6) Claim(s) 1-14 and 16 is/are rejected.
- 7) Claim(s) 15 and 17-19 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 09 March 2004 is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date. _____ .
3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>10/26/04</u> .	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____ .

DETAILED ACTION

Election/Restrictions

13. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-20, drawn to an apparatus for fabricating decoratively shaped writing instruments, classified in class 425, subclass 318.
- II. Claims 21-23, drawn to a method of making a decorative writing utensil, classified in class 264, subclass 322.

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another and materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, process as claimed can be practiced by another and materially different apparatus such as an apparatus with heat lamps used to heat the writing utensil via radiation.

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper. During a telephone conversation between Examiner Sang-Wook An and Atty. Victor Indiana on June 20, 2006, a provisional election was made without traverse to prosecute the invention of Group I, claims 1-20. Affirmation of this election must be made by applicant

in replying to this Office action. Claims 21-23 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

14. The drawings are objected to because the lines, numbers and letters are not uniform, clean and well defined (of a generally poor quality) in each of the twenty-three figures (37 CFR 1.84(l)). Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required

corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Allowable Subject Matter

15. Claims 15 and 17 – 19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 20 is allowed. The following is a statement of reasons for the indication of allowable subject matter: Prior art fails to teach an apparatus for fabricating decoratively shaped writing instruments having a casing, said apparatus comprising: a heater unit comprising a heating tube having a distal opening; a heat source providing heat to said heating tube; a tubular sleeve having a distal opening inserted in the interior of said heating tube and extending through said distal opening of said heating tube, a cover surrounding said heating tube to protect against touching of said heating tube and heat source, a distal end cap having a cover opening attached to said cover, the distal opening of said tubular sleeve being coupled to said cover opening such that a writing instrument casing can be inserted and removed from said heating tube through said cover opening, a gauge assembly comprising, a gauge cover attached to said cover of said heater unit, and a ruler member slideable in said gauge cover to measure the length of the casing inserted in said heater unit; and a shaper unit comprising a platform having a plurality of elongated slots and a mold receiving well having

side walls, an interior mold insert having a interior shaping surface, said interior mold removably insertable in said mold receiving well of said platform; a plurality of exterior mold assemblies, each of said plurality of exterior mold assemblies being attachable to any one of said plurality of elongated slots of said platform, each of said plurality of exterior mold assemblies comprising a rear foot member lockable to said platform, a lever arm, a rear pivot member connecting said lever arm to said rear foot member, a pivot plate, a middle pivot member connecting said lever arm member to said pivot plate, a front foot member, a front pivot member connecting said front foot member to said pivot plate and an exterior shaping surface coupled to said front foot member, said front foot member being moveable in said one of said plurality of elongated slots to which said exterior mold assembly is attached, wherein said lever arm is moveable between a raised position wherein said front foot member and said coupled exterior shaping surface is moved away from said interior shaping surface, and a lowered position wherein said foot member and said coupled exterior shaping surface is moved towards said interior shaping surface; wherein the writing utensil casing is heated in said heater unit, then the heated casing is placed on said platform and is compressed between said interior shaping surface and said exterior shaping surface by movement of said plurality of exterior mold assemblies in said plurality of said elongated slots.

Claim Rejections - 35 USC § 102

16. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 3, 10 – 14 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnston (U.S. 2,696,858). Johnston teaches an apparatus comprising: a heater unit comprising a heat source, and a heating compartment having an opening for inserting and removing the casing, said heat source providing heat to said heating compartment (column 1, lines 15 – 20, 40 – 45); and a shaper unit comprising a platform having an elongated slot (items 5 and 10 – 13 – figure 1; column 2, lines 20 – 35); an exterior mold assembly attachable to said platform and moveable in said elongated slot (item 15 – figure 2; column 2, lines 44 – 46); an exterior shaping surface coupled to said exterior mold assembly (item 15 – figure 2; column 2, lines 48 – 50), and an interior mold insert having an interior shaping surface (item 16 – figure 2; column 2, lines 50 – 52), said interior mold insert being attachable to said platform such that the movement of said exterior mold assembly in said elongated slot moves said exterior shaping surface towards and away from said interior shaping surface (column 2, lines 44 – 58); wherein the casing is heated in said heating compartment, then the heated casing is placed on said platform and is compressed between said interior shaping surface and said exterior shaping surface by movement of said exterior mold assembly in said elongated slot, then the casing is allowed to cool (column 1, lines 44 – 45; column 2, lines 45 – 58); wherein said exterior shaping surface is removably attached to said exterior mold assembly (column 2, lines 45 – 50); wherein the apparatus is further comprised of a plurality of exterior mold assemblies and a plurality of exterior shaping

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surfaces, each of said plurality of exterior shaping surfaces being removably attachable to any one of said plurality of exterior mold assemblies (column 3, lines 1 – 5), and wherein said platform has a plurality of elongated slots, each of said plurality of exterior mold assemblies being attachable to any one of said plurality of elongated slots enabling said apparatus to create different decorative shapes (items 10 – 13 – figure 2; column 2, lines 25 – 30, 44 – 58; column 3, lines 1 – 5, 30 – 45).

With respect to claims 10 – 14, the reference further teaches that the platform comprises a mold receiving well having sidewalls and said interior mold insert further comprises a base having a perimetral surface, said interior shaping surface being attached to said base, wherein said perimetral surface of said base is sized and shaped to fit in said mold receiving well to stabilize said interior shaping surface (figure 2; column 2, lines 50 – 58); wherein said perimetral surface of said base has an irregular shape and said side walls of said mold receiving well has a matching irregular shape, wherein said base only fits in said mold receiving well in one position thereby ensuring that said interior shaping surface is properly oriented in said mold receiving well of said platform (figure 2; column 2, lines 50 – 58; column 3, lines 5 – 15); wherein said exterior mold assembly further comprises a lever arm portion having a lever arm (item 19 – figure 2), said lever arm being moveable between a raised position wherein said exterior shaping surface is moved away from said interior shaping surface, and a lowered position wherein said exterior shaping surface is moved towards said interior shaping surface (column 2, lines 63 – 77; column 3, lines 28 – 31); wherein said exterior mold assembly further comprises a locking portion (column 3, lines 30 – 35) and a moving

portion (column 2, lines 44 – 50), said locking portion including an assembly lock mechanism, wherein said assembly lock mechanism locks said locking portion in place on said platform (column 3, lines 30 – 35), said lever arm portion connects said locking portion to said moveable portion (column 3, lines 25 – 31), and said exterior shaping surface is coupled to said moveable portion (column 3, lines 5 – 15); wherein said exterior mold assembly further comprises a rear foot member (item 21a – figure 2) and a rear pivot member (item 19a – figure 2), said rear pivot member coupling said rear foot assembly to said lever arm portion, and said rear foot assembly and said rear pivot member being part of said locking portion of said exterior mold assembly (column 2, lines 65 – 77).

With respect to claim 16, Johnston further teaches that the exterior mold assembly further comprises a mold holder portion having a main body portion (column 2, lines 59 – 65) and a front foot member, said front foot member being coupled to said exterior shaping surface, said mold holder portion being part of said movable portion of said exterior mold assembly (column 2, lines 65- 75).

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnston in view of Rafferty, et al. (U.S. 6,346,211). Johnston teaches the characteristics previously described but does not teach the specific components of the heating apparatus.

In a method to bend/shape thermoplastic tubes, Rafferty et al. teach a heating element comprised of a block split into two parts (items 6a, 6b – figure 2) made of aluminum. There is a circular channel formed within the block, in which a thermoplastic tube can be placed. In addition, there is a flat plate electrical heater fixed to the outer surface and covered by a sheet of thermal insulation material (column 5, lines 44 – 52). The channel of the heater can be varied depending on the length of tube to be heated. For example, the length of channel can be varied by selecting the appropriate block from a set of blocks of different lengths (column 5, lines 64 – 67; column 6, lines 1 – 5). This reads on the Applicant's claims that the heating compartment further comprises a heating tube having a proximal end and a distal end, said heating tube having an opening at said distal end which provides said opening for inserting and removing the casing; wherein said heat source further comprises a heating element wrapped around said heating tube; wherein said heat source further comprises an interior insulating tape and exterior insulating tape, said interior insulating tape being wrapped around the length of said heating tube, said heating element being wrapped around the length of said interior insulating tape, and said exterior insulating tape being wrapped around said heating element; wherein said heating compartment further comprises a tubular sleeve, said tubular sleeve being inserted in the interior of said heating tube and extending

through said distal opening of said heating tube, wherein, when the casing is inserted in said heating tube, said tubular sleeve is between said casing and the surface of said heating tube.

With respect to Applicant's claims 8 – 9, though not expressly taught by Rafferty, et al. that the heating element include a gauge assembly, it is obvious to one of ordinary skill in the art to include a gauge assembly and ruler member to the heating block. Raffety, et al. already teach that the length of the thermoplastic tube to be heated can be determined by varying the block length, and thus, it would be obvious to include a gauge assembly and ruler member to measure the length of casing inserted, such that the length of the casing can be accurately determined.

Therefore, it would have been obvious to one of ordinary skill in the art to modify the apparatus of Johnston with the heating element of Rafferty, et al. further modified to include a gauge and ruler member, for the purposes of providing an efficient heating element that encloses the material tubing/rattan entirely, thereby heating it completely, while allowing the user to accurately measure the length of tubing/rattan necessary that must be thermoformed.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maria Veronica D. Ewald whose telephone number is 571-272-8519. The examiner can normally be reached on M-F, 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MVE


JOSEPH S. DEL SOLE
PRIMARY EXAMINER
